

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:) Examiner: Horton, Yvonne M.
 Russell John Pylkki et al.) Art Unit: 3635
Serial No: **10/068,070**) Confirmation No.: 7407
Filed: **February 6, 2002**)
For: **SPECIALTY DISPLAY WINDOW)**

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted pursuant to 37 C.F.R. § 41.37 in support of the Notice of Appeal dated March 1, 2007.

1. REAL PARTY IN INTEREST

The real party in interest in the present application is Andersen Corporation, the assignee of the present application.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, or Appellant's legal representatives, that directly affect, will be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

3. STATUS OF CLAIMS

Claims 1-20 are pending in the present application. Claims 1-20 were rejected during prosecution under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over “Switchable Privacy Glass” in view of WO 00/35242. A copy of the claims on appeal (i.e. claims 1- 20) is set forth in the attached Claims Appendix.

4. STATUS OF AMENDMENTS

On March 1, 2007, Appellants filed a Response with a Notice of Appeal responsive to the December 1, 2006 Non-Final Office Action. No other amendments or responses have been filed in response to the December 1, 2006 Non-Final Office Action.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In accordance with 37 C.F.R. §41.37, a concise explanation of the subject matter defined in each of the independent claims involved in the Appeal is set forth below in tabular format. References to pages and lines of the specification are designated “page: lines” and references to the drawings are indicated by reference numerals.

1. A window unit comprising:	FIG. 1 illustrates one particular embodiment of a window unit in accordance with the invention. [2:19-20]
(a) a window frame defining a frame perimeter; and	The window unit 100 includes a window frame 110. The window frame 110 defines a window frame perimeter 120. [2:20-21]
(b) a window located within the frame perimeter, the window includes a display surface adapted to receive a display image;	A window 130, 135 is located within the frame perimeter 120. [2:21-22] The window 135 includes a display surface 140 adapted to receive a display image. [3:11-12]
(c) a display image source disposed in the window frame; and	The window unit may include a display image source 150 disposed in the window frame 110. The display image source 150 can be located in the top frame member 112, the bottom frame member 111, the first side frame member 113 or the second side frame member 114. Alternatively, more than one display image source 150 can be located in the window frame 110 and be located in one or more frame member 111, 112, 113, 114. The display image source 150 may be, for example, a projector. [3:25-30]

<p>(d) a speaker element disposed in the window unit;</p>	<p>The window unit 100 may also include a speaker element 190. The speaker element 190 may be disposed in one or more of the windows 130, 135. The speaker element 190 can be disposed in the main display window 135, one or both side windows 130 or in both the main display window 135 and both side windows 130. The speaker element 190 can produce sound in response to an audio signal. The audio signal may be an analog signal, a digital signal or an analog and digital signal, and the like. The speaker element 190 can be located on or in the window 130, 135. The speaker element 190 may operate in cooperation with the display image source 150 to provide sound to accompany the display images. [4:8-16]</p>
<p>wherein, the window can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface.</p>	<p>The main display window 135 and the two side windows 130 can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface 140. [3:12-14]</p>
<p>14. A method comprising:</p>	<p>FIG. 1 illustrates one particular embodiment of a window unit in accordance with the invention. [2:19-20]</p>
<p>(a) providing a window frame defining a frame perimeter;</p>	<p>The window unit 100 includes a window frame 110. The window frame 110 defines a window frame perimeter 120. [2:20-21]</p>
<p>(b) providing a window within the frame perimeter, the window includes a display surface adapted to receive a display image;</p>	<p>A window 130, 135 is located within the frame perimeter 120. [2:21-22] The window 135 includes a display surface 140 adapted to receive a display image. [3:11-12]</p>
<p>(c) disposing a display image source in the window frame; and</p>	<p>The window unit may include a display image source 150 disposed in the window frame 110. The display image source 150 can be located in the top frame member 112, the bottom frame member 111, the first side frame member 113 or the second side frame member 114. Alternatively, more than one display image source 150 can be located in the window frame 110 and be located in one or more frame member 111, 112, 113, 114. The display image source 150 may be, for example, a projector. [3:25-30]</p>

<p>(d) disposing a speaker element in the window frame;</p>	<p>The window unit 100 may also include a speaker element 190. The speaker element 190 may be disposed in one or more of the windows 130, 135. The speaker element 190 can be disposed in the main display window 135, one or both side windows 130 or in both the main display window 135 and both side windows 130. The speaker element 190 can produce sound in response to an audio signal. The audio signal may be an analog signal, a digital signal or an analog and digital signal, and the like. The speaker element 190 can be located on or in the window 130, 135. The speaker element 190 may operate in cooperation with the display image source 150 to provide sound to accompany the display images. [4:8-16]</p>
<p>wherein, the window can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface.</p>	<p>The main display window 135 and the two side windows 130 can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface 140. [3:12-14]</p>
<p>15. A patio door unit comprising:</p>	<p>Alternatively, embodiments similar to the embodiments shown in FIGS. 1-6 may be constructed using a patio door unit. [6:16-17]</p>
<p>(a) a patio door frame defining a frame perimeter; and</p>	<p>A patio door unit may include one or two doors. The doors may open by sliding or on a hinge. A display image source may be provided in the door frame, the door unit frame or otherwise proximate to the door unit to project an image onto some portion of a glazing unit or units. [6:21-23]</p>
<p>(b) a patio door window located within the frame perimeter, the patio door window includes a display surface adapted to receive a display image;</p>	<p>A patio door unit may also include a stationary component including a glazing unit. [6:18-19]</p> <p>A display image source may be provided in the door frame, the door unit frame or otherwise proximate to the door unit to project an image onto some portion of a glazing unit or units. For example, a patio door unit may include two door and the display image source may project on only the glazing unit or window of only one door, may project one image on the glazing units of both doors, or may</p>

	project two different images onto the glazing units of the two doors. [6:21-26]
(c) a display image source disposed in the patio door frame; and	A display image source may be provided in the door frame, the door unit frame or otherwise proximate to the door unit to project an image onto some portion of a glazing unit or units. [6:21-23]
(d) a speaker element disposed in the patio door unit;	In addition, one, two, or more speaker elements may be disposed in one or more of the windows or glazing units of the patio unit. [6:26-28]
wherein, the patio door window can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface.	One or more of the glazing units in the patio door may be capable of switching from a transparent state to an increased opacity state. [6:19-21]

6. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over “Switchable Privacy Glass” in view of WO 00/35242.

7. ARGUMENT

The rejections based on the proposed combination of WO 00/35242 in view of “Switchable Privacy Glass” and the proposed combination of “Switchable Privacy Glass” in view of WO 00/35242 should be overturned since:

- (1) Even if the proposed combinations were made as asserted by the Examiner, the resulting combinations do not teach all claim elements, since neither reference teaches “a display image source disposed in the window pane.”
- (2) The motivation provided by the Examiner for making the proposed combinations is not taken from the art itself. Since there is no demonstration that the motivation is commonly known by those of skill in the art, the motivation provided by the Examiner is conveniently selected in hindsight only, which is prohibited.

- (1) **Even if the proposed combinations were made as asserted by the Examiner, the resulting combinations do not teach all claim elements, since neither reference teaches “a display image source disposed in the window frame.”**

Neither the combination of WO 00/35242 in view of “Switchable Privacy Glass” nor the combination of “Switchable Privacy Glass” in view of WO 00/35242, even if somehow made as proposed, provides all elements of the present claims. In particular, neither “Switchable Privacy Glass” nor WO 00/35242 teaches “a display image source disposed in the window frame” as claimed.

According to MPEP §2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” “Switchable Privacy Glass” only discloses a separate projector spaced from the window/screen in the middle of the room and not a display image source “in the window frame” as claimed. WO 00/35242 fails to teach a display image source whatsoever. Thus, since neither “Switchable Privacy Glass,” WO 00/35242, nor any combination thereof teaches or suggests each and every claim element, a *prima facie* case of obviousness under 35 USC §103 has not been established.

- (2) **The motivation provided by the Examiner for making the proposed combinations is not taken from the art itself. Without support for the assertion that such motivation is commonly known by those of skill in the art, the motivation provided by the Examiner is conveniently selected in hindsight only, which is prohibited.**

Neither WO 00/35242 nor “Switchable Privacy Glass” provides the requisite suggestion or motivation to combine their teachings. The Examiner asserted that:

“it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the window unit of WO 00/35242 with the transparent/opaque transmittable window/glass pane of “Switchable Privacy Glass” in order to control the vision therethrough both during the day and night

hours. Providing a window unit with the ability to be opaque allows sunlight to shine through during the day and permits privacy during evening hours without the hassle of curtains, blinds, or other assemblies used to cover windows.”

Since the asserted motivation to combine is not taken from the references and is not shown to be common knowledge to those of ordinary skill in the art, this motivation is inadequate. Without the requisite motivation, the Examiner has failed to provide a *prima facie* case of obviousness. In fact, there can be no motivation to combine these references because a display screen must be stable and rigid to display a sharp image. A vibrating window pane, which would result from the proposed combination, would render the window pane unsuitable for use as a video screen. Thus, to the extent there is any motivation at all, it favors not combining these two references. Accordingly, since the Examiner failed to provide a *prima facie* case of obviousness, these rejections should be overturned.

In order to establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Interf. 1993); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts or it cannot stand. See *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on 35 U.S.C. § 103(a) therefore clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art or “viewed after the event.” *Goodyear Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). The proper inquiry thus is whether bringing the references together was

obvious and not, whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention. Accordingly, an Examiner cannot establish obviousness by locating references that describe various aspects of the claimed invention without also providing evidence of the motivating force that would lead one skilled in the art to do what the inventor has done.

Appellants timely traversed the reasoning/rational supplied by the Examiner, and specifically detailed why combinations of WO 00/35242 and “Switchable Privacy Glass” are improper and fail to establish a *prima facie* case of obviousness. As detailed in the Response filed September 19, 2006 and the Response filed March 1, 2007, WO 00/35242 teaches a loudspeaker that vibrates a pane of glass to produce acoustic output. Every window shown in WO 00/35242 includes a vibratory speaker element, and there is no motivation in the cited art to replace a window of WO 00/35242 with a “Switchable Privacy Glass” window. Assuming, *arguendo*, that such motivation existed, the combination would yield a switchable window with vibratory exciters. This is nonsensical. One of ordinary skill would not be motivated to create a vibrating glass speaker that is switchable to a non-transparent state. Further, one would not be motivated to create a vibratory display pane to display images – since the images would vibrate. Clearly, absent the present invention’s teachings, no motivation exists in these references to make the proposed combination.

The new rejections of claims 1-20 based on “Switchable Privacy Glass” in view of WO 00/35242 also fail to provide support for the proposed combination. Even if supported by a motivation to replace a “Switchable Privacy Glass” window with a WO 00/35242 window (no such motivation is shown or taught), the combination would yield a switchable window with vibratory exciters. As mentioned above, one of ordinary skill would not be motivated to create a

vibratory display pane to display images and sound. Such display screens must remain stationary and rigid and vibrating a display screen runs contrary to this essential requirement. Clearly, absent the present invention's teachings, no motivation exists in these references that would teach or suggest the proposed combination.

The Examiner failed to provide a basis either for maintaining the original rejection or for the addition of the new rejection, which is merely based upon the same references, only reversed. The only explanations of the new rejections were comments by the Examiner of speculative areas that one could be inspired to utilize either WO 00/35242 or "Switchable Privacy Glass." This speculation without requisite support clearly fails to meet the burden described in section IV of MPEP 2143.01, which states that even if the prior art references teach all aspects of the invention individually (which, as discussed above, they do not in the present case), the Examiner fails to meet the burden of presenting a *prima facie* obviousness when there is no objective reason to combine the references. The prior art combinations asserted in the present application fails to provide all elements of the claimed invention and, even if it did, the reasons proposed by the Examiner for such combination fail entirely to meet the burden of demonstrating a *prima facie* case of obviousness.

Further, Section V of MPEP 2143.01, is entitled and provides that "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE." This would be the precise result if the references asserted in either combination were combined. A vibratory display panel, the purported teaching from WO 00/35242, would be unsatisfactory for displaying images as previously discussed. Since the resulting vibrating display panel would render "Switchable Privacy Glass" unsatisfactory for its intended purpose, i.e. a stable un-moving surface for the projection of images, one of ordinary

skill in the art would not be motivated to combine these references. The motivation is in fact not to do so.

Without establishing a *prima facie* case of obviousness, maintenance of the rejections and the imposition of additional rejections based on the same art reversed fail to advance prosecution. These rejections are unfounded and should not have been made or maintained without the Examiner providing the requisite suggestion or motivation to combine.

For at least the foregoing reasons, the rejections under 35 USC §103(a) are improper and should be overturned. The claims are not obvious in view of the prior art, and are thus allowable over such art.

8. CLAIMS APPENDIX

A Claims Appendix detailing the claims involved in the Appeal is attached hereto beginning after page 13.

9. EVIDENCE APPENDIX

An Evidence Appendix is attached hereto, but, since no additional evidence has been entered or relied upon in this Appeal, the Evidence Appendix contains no information.

10. RELATED PROCEEDINGS APPENDIX

A Related Proceedings Appendix is attached hereto, but, since there are no related appeals and interferences, and since neither a Court nor the Board in any proceeding is identified in the related appeals and interferences section, the Related Proceedings Appendix contains no information.

CONCLUSION

Reversal of the rejections and allowance of these claims is respectfully requested.

Respectfully submitted,

5/1/07
Date

Keats A. Quinalty
Keats A. Quinalty
Reg. No. 46,426

Customer No. 26158
WOMBLE CARLYLE SANDRIDGE & RICE
P. O. Box 7037
Atlanta, Georgia 30357-0037
Telephone: (404) 879-2423
Facsimile: (404) 879-2923

Docket No.: A202 1460

CLAIMS APPENDIX

1. A window unit comprising:
 - (a) a window frame defining a frame perimeter; and
 - (b) a window located within the frame perimeter, the window includes a display surface adapted to receive a display image;
 - (c) a display image source disposed in the window frame; and
 - (d) a speaker element disposed in the window unit;wherein, the window can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface.
2. The window unit of claim 1 wherein, the window unit comprises a single window.
3. The window unit of claim 1 wherein, the window unit comprises a plurality of windows.
4. The window of claim 2 wherein, the window unit is a picture window.
5. The window of claim 3 wherein, the window unit is a bay window including a main display window between two side windows.
6. The window of claim 5 wherein, the speaker element is disposed in a side window.
7. The window of claim 5 wherein, the speaker element is disposed in each side window.

8. The window of claim 5 wherein, the speaker element is disposed in the main display window.
9. The window of claim 5 wherein, the speaker element is disposed in each side window and main display window.
10. The window of claim 1 wherein, the window frame includes a first pair of opposed frame members, which includes a bottom frame member and a top frame member oriented along a horizontal rigid frame axis and a second pair of opposed rigid frame members, which includes a first side frame member and a second side frame member can be oriented along a vertical frame axis, the display image source disposed in the bottom frame member, top frame member, first side member, or second side member.
11. The window of claim 10 wherein, the display image source is disposed in the bottom frame member.
12. The window of claim 10 wherein, the display image source is disposed in the top frame member.
13. The window of claim 10 wherein, further comprising a second display image source disposed in the bottom frame member, top frame member, first side member, or second side member.
14. A method comprising:
 - (a) providing a window frame defining a frame perimeter;
 - (b) providing a window within the frame perimeter, the window includes a display surface adapted to receive a display image;

- (c) disposing a display image source in the window frame; and
- (d) disposing a speaker element in the window frame;

wherein, the window can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface.

15. A patio door unit comprising:

- (a) a patio door frame defining a frame perimeter; and
- (b) a patio door window located within the frame perimeter, the patio door window includes a display surface adapted to receive a display image;
- (c) a display image source disposed in the patio door frame; and
- (d) a speaker element disposed in the patio door unit;

wherein, the patio door window can transform from a first transparent state to a second increased opacity state for receiving the display image on the display surface.

16. The patio door unit of claim 15 wherein, the patio door unit comprises a single patio door.

17. The patio door unit of claim 15 wherein, the patio door unit comprises a plurality of patio door windows.

18. The patio door of claim 15 wherein, the patio door frame includes a first pair of opposed frame members, which includes a bottom frame member and a top frame member oriented along a horizontal rigid frame axis and a second pair of opposed rigid frame members, which includes a first side frame member and a second side frame member can be oriented along a vertical frame axis, the display image source disposed in the bottom frame member, top frame member, first side member, or second side member.

19. The patio door of claim 18 wherein, the display image source is disposed in the bottom frame member.

20. The patio door of claim 18 wherein, the display image source is disposed in the top frame member.

EVIDENCE APPENDIX

Since no additional evidence has been entered or relied upon in this Appeal, this Evidence Appendix contains no information.

RELATED PROCEEDINGS APPENDIX

Since there are no related appeals and interferences, this Related Proceedings Appendix contains no information. Further, since neither a Court nor the Board in any proceeding is identified in the related appeals and interferences section, no information is provided.